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10/531,045

04/12/2005

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MAM-062

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07/29/2008

EXAMINER

MAPLES, JOHN S

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

07/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/531,045 | Applicant(s) JITO ET AL. | |
| | Examiner John S. Maples | Art Unit 1795 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 23-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-22 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election without traverse of Group I in the reply filed on 2 May 2008 is acknowledged.

2. Claims 23-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 18-20, there is no antecedent basis for "cyclic carbonate having an unsaturated carbon bond".

Claim 21 is unclear and indefinite because this claim recites a content of the cyclic carbonate having an unsaturated bond and recites an exclusion of the the cyclic carbonate having an unsaturated carbon bond. Clarification of this claim language is required.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the

subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3, 5, 8-10, 12-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-2003-007295 ('295-corresponds to JP-02/071512) in view of applicant's admitted prior art. (AAPA)

Reference is made to paragraphs 30 and 44-51 of '295 for a noncrystalline (amorphous) silicon film with cobalt therein for use as an anode in a non-aqueous battery, which electrolyte includes the claimed vinylene carbonate and dimethyl carbonate and the recited salts. It is noted that paragraphs 33-34 in '295 disclose roughening the current collector. The only claimed features not shown by '295 are the carbon dioxide in the electrolyte and the specific roughness of the current collector. As set forth on page 4 of the present specification, AAPA states that carbon dioxide is present when producing a non-aqueous battery. It therefore would have been obvious to one of ordinary skill in this art at the time the invention was made to have the battery of '295 include the claimed amounts of carbon dioxide as taught by AAPA because the same would be present during manufacture thereof. It would also have been obvious to make the roughness of the current collector in '295 of 0.1 microns because the same would allow for better adhesion of the active material on the electrode.

8. Claims 1-3, 5, 8-10, 12-15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-01-029913 ('913) in view of applicant's admitted prior art. (AAPA)

Reference is made to page 1, lines 1-32; page 4, lines 20-28; the last 3 lines of page 5 through page 6, line 8 and the last 7 lines on page 7 through line 9 on page 8 of '913 for a noncrystalline (amorphorous) silicon film that may include cobalt or iron therein for use as an anode in a non-aqueous battery, which electrolyte includes the claimed propylene carbonate or ethylene carbonate and dimethyl carbonate and the recited salts. It is noted that lines 5-6 on page 6 in '913 disclose roughening the current collector that includes the claimed 0.1 micron size. The only claimed feature not shown by '913 is the carbon dioxide in the electrolyte. As set forth on page 4 of the present specification, AAPA states that carbon dioxide is present when producing a non-aqueous battery. It therefore would have been obvious to one of ordinary skill in this art at the time the invention was made to have the battery of '913 include the claimed amounts of carbon dioxide as taught by AAPA because the same would be present during manufacture thereof.

9. Claims 4, 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over either '295 or '913, each taken in view of both JP-10-040958 ('958) and Eschbach et al.-US 5,681,357. ('357)

The only claimed features not shown by both '295 and '913 is the specific amount of carbon dioxide and for the copper alloy current collector. The '958 reference teaches the claimed amount of carbon dioxide in a non-aqueous lithium secondary

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battery as set forth in the abstract. To include in either '295 or '913 the amount of carbon dioxide as set forth in '958 would have been obvious to prolong the said battery life. The '357 patent teaches in column 3, lines 8-24 a copper alloy current for a non-aqueous lithium secondary battery and to include the same in either '295 or '913 would have been obvious because the same provides excellent current conduction for the battery cell and is a straightforward substitution in this art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Maples whose telephone number is 571-272-1287. The examiner can normally be reached on Monday-Friday, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John S. Maples/

John S. Maples
Primary Examiner
Art Unit 1795

JSM/7-18-2008